

REMARKS

This is a full and timely response to the outstanding Office action mailed September 23, 2004. Upon entry of the amendments in this response claims 1-58 are pending. More specifically, claims 1, 13, 24, 35, and 47 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claims 1-3, 8-11, 13-16, 19-22, 24-27, 30-33, 35-38, 41-44, 47-50 and 53-56 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Jain *et al.* (USPN 6,085,101). Claims 1-9, 13-20, 24-31, 35-42, 46-54, and 58 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to Pershan *et al.* Claims 1, 12, 13, 23, 24, 34, 35, 45, 47, and 57 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to Brown *et al.*

II. Rejections Under 35 U.S.C. §102(b)**A. Claims 1-12**

The Office Action rejects claims 1-3 and 8-11 under 35 U.S.C. 102(b) as allegedly being anticipated by Jain *et al.* (U.S. Patent No. 6,085,101). Claims 1-9 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to Pershan *et al.* Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to Brown *et al.* For the reasons set forth below, Applicant respectfully traverses the rejections.

Independent claim 1 recites:

1. A method of arranging for an electronically-recorded message to be delivered to a communication medium of a recipient at a selected time, said method comprising the steps of:
recording the message on a stand-alone communication device;
inputting an access code for accessing the communication medium of the recipient; and

indicating a delivery time for deliver of the message from the stand-alone communication device to the communication medium of the recipient.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that none of *Jain*, *Pershan*, or *Brown* discloses, teaches, or suggests at least **recording the message on a stand-alone communication device**. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, none of *Jain*, *Pershan*, or *Brown* anticipates claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited art of record, dependent claims 2-12 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-12 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-12 are patentable over *Jain*, the rejection to claims 2-12 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-12 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-12 are allowable.

B. Claims 13-23

Claims 13-16 and 19-22 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Jain et al.* (USPN 6,085,101). Claims 13-20 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to *Pershan et al.* Claims 13 and 23 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to *Brown et al.* For the reasons set forth below, Applicant respectfully traverses the rejections.

Independent claim 13 recites:

13. A method of sending an electronically-recorded message to a communication medium of a recipient at a selected time, said method comprises the steps of:

recording the message on a stand-alone communication device;

inputting an access code for accessing the communication medium of the recipient;

indicating a delivery time for delivery of the message to a communication medium of the recipient; and

sending the message from the stand-alone communication device to the communication medium of the recipient when the time reaches the delivery time.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 13 as amended is allowable for at least the reason that none of *Jain*, *Pershan*, or *Brown* discloses, teaches, or suggests at least **recording the message on a stand-alone communication device**. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, none of *Jain*, *Pershan*, or *Brown* anticipates claim 1, and the rejection should be withdrawn.

Because independent claim 13 as amended is allowable over the cited art of record, dependent claims 14-23 (which depend from independent claim 13) are allowable as a matter of law for at least the reason that dependent claims 14-23 contain all the steps/features of independent claim 13. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 14-23 are patentable over *Jain*, the rejection to claims 14-23 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 13, dependent claims 14-23 recite further features and/or combinations of features, as are

apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 14-23 are allowable.

C. Claims 24-34

Claims 24-27 and 30-33 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Jain *et al.* (USPN 6,085,101). Claims 24-31 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to Pershan *et al.* Claims 24 and 34 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to Brown *et al.* For the reasons set forth below, Applicant respectfully traverses the rejections.

Independent claim 24 recites:

24. A method of sending an electronically-recorded message to oneself at a selected time, said method comprising the steps of:

recording the message on a stand-alone communication device;

inputting an access code for accessing a communication medium of oneself;

indicating a delivery time for delivery of the message to the communication medium of oneself; and

sending the message from the stand-alone communication device to the communication medium of oneself when the time reaches the delivery time.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 24 as amended is allowable for at least the reason that none of Jain, Pershan, or Brown discloses, teaches, or suggests at least **recording the message on a stand-alone communication device**. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, none of Jain, Pershan, or Brown anticipates claim 24, and the rejection should be withdrawn.

Because independent claim 24 as amended is allowable over the cited art of record, dependent claims 25-34 (which depend from independent claim 24) are allowable as a matter of

law for at least the reason that dependent claims 25-34 contain all the steps/features of independent claim 24. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 25-34 are patentable over *Jain*, the rejection to claims 25-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 24, dependent claims 25-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 25-34 are allowable.

D. Claims 35-46

Claims 35-38 and 41-44 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Jain *et al.* (USPN 6,085,101). Claims 35-42 and 46 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to Pershan *et al.* Claims 1, 35 and 45 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to Brown *et al.* For the reasons set forth below, Applicant respectfully traverses the rejections.

Independent claim 35 recites:

35. A system for arranging an electronically-recorded message to a communication medium of a recipient at a selected time, said system comprising:

means for recording a message on a stand-alone communication device;

means for inputting an access code for accessing a communication medium of a recipient;

means for indicating a delivery time for delivery of the message to a communication medium of the recipient; and

means for sending the message from the stand-alone communication device to the communication medium of the recipient when the time reaches the delivery time.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 35 as amended is allowable for at least the reason that none of *Jain*, *Pershan*, or *Brown* discloses, teaches, or suggests at least **means for recording a message on a stand-alone communication device**. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, none of *Jain*, *Pershan*, or *Brown* anticipates claim 35, and the rejection should be withdrawn.

Because independent claim 35 as amended is allowable over the cited art of record, dependent claims 36-46 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-46 contain all the steps/features of independent claim 35. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 36-46 are patentable over *Jain*, the rejection to claims 36-46 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-46 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-46 are allowable.

E. Claims 47-58

Claims 47-50 and 53-56 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Jain et al.* (USPN 6,085,101). Claims 47-54, and 58 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,260,986 to *Pershan et al.* Claims 47 and 57 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,333,180 to *Brown et al.* For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 47 recites:

47. A system for sending an electronically-recorded message to a communication medium of a recipient at a selected time, said system comprising:

means for recording a message on a stand-alone communication device;

means for inputting an access code for accessing a communication medium of a recipient;

means for indicating a delivery time for delivery of the message to a communication medium of the recipient;

means for keeping track of a clock time; and

means for sending the message from the stand-alone communication device to the communication medium of the recipient when the time reaches the delivery time.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 47 as amended is allowable for at least the reason that none of *Jain*, *Pershan*, or *Brown* discloses, teaches, or suggests at least **means for recording a message on a stand-alone communication device**. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, none of *Jain*, *Pershan*, or *Brown* anticipates claim 47, and the rejection should be withdrawn.

Because independent claim 47 as amended is allowable over the cited art of record, dependent claims 48-58 (which depend from independent claim 47) are allowable as a matter of law for at least the reason that dependent claims 48-58 contain all the steps/features of independent claim 47. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 48-58 are patentable over *Jain*, the rejection to claims 48-58 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 47, dependent claims 48-58 recite further features and/or combinations of features, as are

apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 48-58 are allowable.

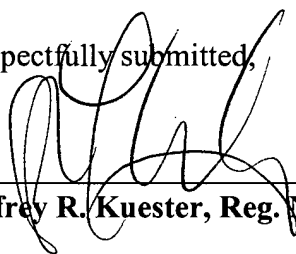
III. Cited Art Made of Record

The cited art made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-58 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**

Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500